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• **Comments:**

In re Application of: **GORTZ, et al.**

Serial No.: **10/510,477**

Filing Date: **October 7, 2004**

Attachments: **REPLY to Office Action of September 6, 2005.**

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE APPLICATION

ATTY. DOCKET: PF++53405

OF: GÖRTZ ET AL.

CONFIRMATION No.: 7354

SERIAL No. 10/510,477

GROUP ART UNIT: 1711

FILED: OCTOBER 07, 2004

EXAMINER: DUC TRUONG

FOR: PRODUCTION OF POLYOXYMETHYLENE AND SUITABLE (II) CATALYSTS

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REPLY UNDER 37 C.F.R. §1.111

Sir:

In reply to the Office action of September 06, 2005, it is respectfully requested that the following remarks be entered and considered for further prosecution of the above-identified application:

REMARKS

Claims 1 to 9 as preliminarily amended upon filing of the application are currently pending in this case.

The Examiner rejected Claims 8 and 9 under 35 U.S.C. §102(b) as being anticipated by the teaching of *Edelmann et al.* (J. Org. Chem. 309, 87 (1986)), pointing in particular to certain $(\eta^3\text{-C}_5\text{H}_4\text{CHO})\text{M}(\text{CO})_3\text{Sn}(\text{CH}_3)_2$ compounds, or complex salts, addressed on page 92 of the

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reference and to *Edelmann et al.*'s disclosure that the $\text{Sn}(\text{CH}_3)_2$ moiety may be replaced by halogen or $\text{Au}(\text{PPh}_3)$. However, applicants' Claims 8 and 9 specifically relate to compounds in which the anion, represented by Z of applicants' formula (Ia), is trifluoromethanesulfonate, trifluoroacetate, tetrafluoroborate, hexafluorophosphate or hexafluoroantimonate. Neither one of the complex salts which are addressed in the teaching of *Edelmann et al.* comprises one of the groups which are enumerated in applicants' definition of Z as set forth in Claim 8 and incorporated into Claim 9 by reference to Claim 8.

Anticipation under Section 102 can be found only if a reference shows exactly what is claimed.¹⁾ The test for anticipation is one of identity, the identical invention must be shown in the reference in as complete detail as is contained in the claim.²⁾ Since *Edelmann et al.* fail to address complex salts in which the anion meets the provisions of applicants' moiety Z, the respective teaching can clearly not be considered to provide an identical description of applicants' invention as is required for a finding of anticipation under Section 102. It is therefore respectfully requested that the rejection of Claims 8 and 9 based on the teaching of *Edelmann et al.* be withdrawn.

For essentially the same reasons it is respectfully requested that the Examiner withdraw the rejection of Claims 8 and 9 under 35 U.S.C. §102(b) as being anticipated by the teaching of *Chaloyard et al.* (*Inorg. Chem.* **19**, 3217 (1980)) which solely describes complex salts in which the anion is iodide. Favorable action is solicited.

Additionally, the Examiner rejected Claims 1 to 7 under 35 U.S.C. §103(a) as being unpatentable in light of the teaching of *GB 1,187,233* when taken in view of the disclosure of *Edelmann et al.* (*ibid.*) and of *Chaloyard et al.* (*ibid.*). The Examiner argued in this context inter alia that *Edelmann et al.* and *Chaloyard et al.* disclosed "that the ring substituted derivatives of cyclopentadienyl tricarbonyl complexes are included in organometallic complex cations and can be used as catalyst".³⁾ However, neither *Edelmann et al.* nor *Chaloyard et al.* suggest or imply that the referenced complex salts exhibit any catalytic activity. The respective references merely ad-

1) Cf. *Titanium Metals Corp. v. Banner*, 778 F.2d 775, 227 USPQ 773 (Fed. Cir. 1985); *In re Marshall* 577 F.2d 301, 198 USPQ 344 (CCPA 1978); *In re Kalm* 378 F.2d 959, 154 USPQ 10 (CCPA 1967).

2) Cf. *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 9 USPQ2d 1913 (Fed. Cir. 1989).

3) Eg. page 3, lines 8 to 10, of the Office action dated September 06, 2005.

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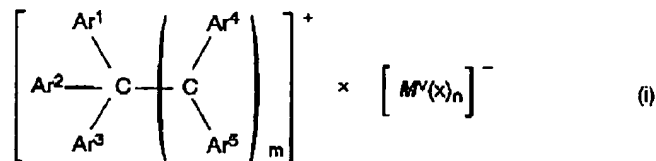
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dress the synthesis of the complex cations, and some of their physical characteristics.

The Examiner further pointed out that GB 1,187,233 as described a preparation of polyoxymethylene by polymerizing formaldehyde or trioxane, or another source for oxymethylene units, in the presence of certain organometallic complex cation, and argued that it would have been obvious for a person of ordinary skill in the art to replace the complex cations referenced in the British reference by one of the complex cations addressed by *Edelmann et al.* and/or *Chaloyard et al.* It has to be noted, however, that the complex salts which are employed in the polymerization described in the British reference are represented by formula (i)⁴⁾



and that the coordinating metal *M* of said complex salts is a part of the anion rather than the cation whereas. The metal of the catalysts which are employed in accordance with the teaching of GB 1,187,233 is, accordingly, part of a negatively charged part of the complex salt. In contrast thereto, the complex salts addressed by *Edelmann et al.* and/or *Chaloyard et al.* comprise the metal as part of the cation, i.e. the metal is part is the positively charged part of the complex salt. The complex salts which are used in GB 1,187,233 to catalyze the manufacture of oxymethylene polymers are, therefore distinctly different from the complex salts which are addressed in the secondary references relied upon by the Examiner. Bearing in mind the distinct structural differences between the complex salts and the fact that the secondary references are silent as to a catalytic effectivity of the specified $(\eta^5\text{-C}_5\text{H}_4\text{CHO})\text{M}(\text{CO})_3$ compounds, the Examiner's position that a person of ordinary skill in the art would have been motivated to replace the catalysts employed in accordance with the British reference by one of the complex salts addressed in the secondary references is not deemed to be well taken.

The Examiner also argued that the respective complex salts had the same functionality. However, the information about the functionality of the complex salts described by *Edelmann et al.* and by *Chalo-*

4) Cf. eg. page 1, indicated line 40, and page 2, indicated line 9, of GB 1,187,233.

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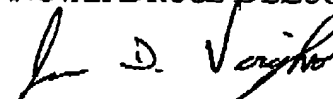
yard et al. as catalysts in the preparation of polyoxymethylene is not provided by the prior art relied upon by the Examiner in the rejection. Rather, the Examiner gleans this information from the disclosure which applicants' provided of their invention. The respective argument is, therefore, not deemed to be permissible in the determination whether the subject matter of applicants' claims was obvious at the time applicants' made their invention. To imbue one of ordinary skill in the art with the knowledge of the invention in suit, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein which only the inventor taught is used against the teacher.⁵⁾

For the foregoing reasons applicants' are of the opinion that the teaching of GB 1,187,233 when taken in view of the disclosures of Edelmann et al. and of Chaloyard et al. cannot be considered to render applicants' invention prima facie obvious within the meaning of Section 103(a). Favorable reconsideration of the Examiner's position and withdrawal of the rejection is, therefore, respectfully solicited.

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Respectfully submitted,

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5) Cf. *Gore & Assoc., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 230 USPQ 303 (Fed. Cir. 1983).

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